REMARKS/ARGUMENTS

The rejections presented in the Office Action dated May 17, 2006 (hereinafter Office Action) have been considered. Claims 1, 2, 4-7, 10-32 and 34-49 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

The drawings were objected to under 37 C.F.R. 1.83(a) for failing to show every feature of the claims. According to the Office Action, "a URL that is unique to a particular instance of an item must be shown or the feature(s) canceled from the claim(s)." The Applicants respectfully direct the Examiner's attention to FIG. 5 and page 16, lines 8-13 of the Specification as filed, which states:

> Returning to our example of the refrigerator with its constituent pump and service contract, it can be seen that pump 500, with unique identification code 502, has a webpage 504 which presents the information gathered by supplier, manufacturer, distributor and consumer with respect to the pump 500. Unique identification code 502 is a URL pointing to webpage 504.

Therefore, the Applicants submit that the drawings comply with 37 C.F.R. 1.83(a) because reference 502 in FIG. 5 shows a URL unique to a particular instance of an item, the pump 500.

Claims 1, 2, 4-7, 10-32 and 34-40 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter. According to the Office Action, the phrase "a particular instance of an asset" is unclear. According to the Examiner:

> This phrase does not exist in applicant's specification and it is not clear if this term means each individual asset or each type of asset. For example, is pump 302 from applicant's specification generic pump model 302 or is it pump number 302? For purposes of examination, based on applicant's figure 5, the examiner will consider the term to be a type of asset. It would be extremely helpful if applicant used claim language, which is consistent with [sic] it's specification. This will aid in avoiding unclear language and possible new matter. (Office Action, page 3).

The Applicants respectfully respond that, as it would be clear to one of ordinary skill in the art that any of the terms "asset," "particular asset," "particular asset item," "particular

instance of an asset," etc., as used in the claims and specification, are intended to describe individual items. This interpretation is fully supported in Applicants' Specification, and the Applicants have consistently argued this interpretation during prosecution. For example, see the Office Action Responses filed on October 1, 2003 ("For example, a home electronics retailer may obtain information about a television returned for repair by utilizing a URL that is uniquely associated with the particular television.") and March 4, 2004 ("Despite the fact that two televisions are made by the same manufacturer and are of the same model, the two televisions are identified by different URLs.").

At to the use of the term "instance," Applicants note that the claims do not need to use the exact language of the specification. Regarding the Examiner's contention that the term "particular instance of an asset" is indefinite, the Applicants first note that, according to MPEP § 2173, the purpose of the definiteness standard is

> to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C 112, first paragraph with respect to the claimed invention.

Further, MPEP § 2173.02 sets forth the standard for the definiteness requirement

> The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:
>
> (A) The content of the particular application disclosure;
>
> (B) The teachings of the prior art; and
>
> (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In light of these requirements, Applicants first submit that the term "particular instance of an asset" is clear on its face. Although the Examiner states that "it is not clear if this term means each individual asset or each type of asset," the Examiner also answers this question by citing dictionary definitions on page 3 the Office Action: "Particular – of,

relating to, or being a single person or thing" and "Instance – an individual illustrative of a category." (emphasis added). Therefore the Applicants submit that the term "particular instance of an asset," is definite and distinctly points out and claims the subject matter which Applicants regard as the invention. This term is definite on its face, and particularly when viewed in light of the content of the Specification, the teachings of the prior art, and meanings such a term would have to one with ordinary skill in the pertinent art. Withdrawal of the rejection is therefore respectfully solicited.

As to the Examiner's remarks regarding possible new matter using the term "particular instance of an asset," the Applicants note that MPEP § 2163.07 states "[m]ere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973)." The Applicants submit that the Specification fully supports the interpretation of "instance" as referring to individual items, and respectfully disagree with the Examiner's interpretation of the term "particular instance of an asset" as "a type of asset." First, Applicants refer to page 5, lines 24-26 of the Specification, which states "[a]n asset may include or be represented by any item, tangible or intangible, which may be passed among parties." It would be unreasonable to assume that this passage is referring to "types of assets," because a "type" is an abstraction applied to groups of related things, and it would be unreasonable to suggest that abstract "types" are "passed among parties."

Page 6, lines 9-11 of the Specification, states "a party in possession of an asset to be able to unearth information about that asset armed only with knowledge derivable from the asset itself." This knowledge includes "transactions and operations of which a particular asset has been the subject." Again, it is unreasonable to suggest that parties can be in possession of "types" of things, because types are merely abstractions used to describe groups of related objects, thus the term "asset" as used here clearly refers to the individual items themselves. Further, it would be unreasonable to suggest that this type of knowledge about "transactions and operations" refers to "transactions and operations" on types or categories of objects, such as objects referenced by a part number. The only way such an

interpretation of an "asset" would be reasonable is if all instances of a given type underwent the same transactions and operations, and this was neither suggested in the Specification nor would one of ordinary skill in the art make such an assumption about supply chain assets in the context of the present disclosure.

The Specification contains numerous other examples of individual items that are described as set forth in Applicants' claims. For example, "a supplier sells a lot of pumps to a manufacturer; (b) operation 202, in which a manufacturer assembles a refrigerator using one of the pumps from the sold lot ...Assuming a transaction/operation-based information tracking system is employed to track asset information about the pump (which is an example of an asset)" (Specification, page 8 line 29 to page 9, line 4)(emphasis added). Clearly the transactions are described in reference to an individual pump, and later transactions involving the pump are described in reference to individual items of which the pump is constituent (e.g., "the manufacturer of the refrigerator installs the pump in a refrigerator," Specification p. p, lines 7-8).

This example of an individual pump is carried through in further descriptions related to FIGS. 3 and 5. Regarding FIG. 3, see p. 10, line 18 ("Figure 3 depicts the supply chain discussed in Figure 2") and lines 27-28 ("while in the hands of supplier, pump 302 is given a unique identification code 304"). Regarding FIG. 5, see p. 16, lines 8-9 ("Returning to our example of the refrigerator with its constituent pump and service contract"). Nowhere does the Specification imply that the identification codes applied to pumps in general, nor does it imply that the unique identifier is applicable to all instances of the type of pump. An identification code that is applicable to all instances of the pump could hardly be used to determine "information regarding the asset is stored in association with that unique identification code throughout the lifecycle of the asset." (Specification, p. 13, lines 25-26). Contrary to the Examiner's assertion that it is unclear whether the description of pump 302 in FIG. 3 refers to "generic pump model 302 or ... pump number 302," the Applicants submit that when viewed in the context of the Specification as a whole, it is clear that pump 302 refers to an individual pump.

Even in the local context of the description of FIG. 3, it would be unreasonable to suggest that pump 302 refers to a "generic pump model." In addition to the examples given above, the Applicants refer to page 12, lines 26-27 ("When the refrigerator 308 and its constituent pump 302 are purchased by the retailer 312"), page 14, lines 1-2, ("Using such a system, the consumer 318 may take a broken refrigerator 308 to a repair shop for repair of a broken pump 302"), page 14, lines 5-9 ("The supplier 300 of the pump 302 may deduce information regarding the performance of its pumps by keeping track of its identifications codes, such as unique identification code 304, and periodically searching for additional information gathered by downstream supplier entities and stored in association with unique identification number 304."). In particular, the Applicants submit that the last quoted passage indicates that the identification codes are unique to individual pumps, as it is stated "may deduce information regarding the performance of its pumps by keeping track of its identifications codes." If the identification code was common to all instances of the type of pump, this phrase would have used the singular "code" instead of the plural "codes."

In conclusion, Applicants respectfully submits that the term "particular instance of an asset" in unambiguous, and the Applicants further respectfully request that the claims be given interpretations that are not only consistent with the Specification, but that also would be apparent to one of ordinary skill in the art based on the language of the claims. Should the Examiner continue to object to the claim language, it is respectfully requested that the Examiner contact the undersigned attorney of record by telephone so that this issue can be resolved by ascertaining language that is both satisfactory to the Examiner and unambiguously descriptive of the Applicants' claimed invention.

Claims 1, 2, 4-7, 10-32 and 34-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,950,173 to *Perkowski* (hereinafter "Perkowski") in view of U.S. Patent No. 5,804,803 to *Cragun et al.* (hereinafter "Cragun"). The Applicants respectfully traverse the rejection. However, in order to facilitate prosecution of the application and in a *bona fide* attempt to advance the application to allowance, the Applicants present this response with amendment to clarify particular aspects of the claimed

invention. These amendments make more clear what is believed to have been originally set forth in these claims, but now states so more specifically.

Particular claims have been amended to at least set forth that the information pertaining to assets is entered into a centralized asset tracking datastore by independent supplier entities that handle the asset item during the item's processing through the supply chain. For example, Claim 1 sets forth that the information pertaining to a particular instance of an asset is recorded in an independent datastore by an upstream supplier entity. Additional information pertaining to the particular instance of the asset is recorded in the independent datastore by a downstream supplier entity. The remaining independent claims also define this recording of data pertaining to the individual assets of a supply chain being performed by the respective supplier entities within the supply chain.

In the Office Action, the Examiner relies on *Perkowski* to show recording information pertaining to a particular instance of an asset that is provided by upstream and downstream suppliers. *Perkowski* is generally directed to a supply chain management system that "embraces the manufacturers, retailers, and consumers of UPC-encoded products." (col. 11, lines 22-24). In relation to *Perkowski's* FIG. 1, *Perkowski* describes a number of independent information subsystems, including UPC information subsystem, an Internet Product Information (IPI) finding delivery subsystem, sales and analysis forecasting subsystem, collaborative replenishment subsystem, electronic trading subsystem, and transportation and logistics information subsystem. *Perkowski* describes the operation of these subsytems on column 1, line 38 to column 2, line 19. However, nowhere does Perkowski describe two or more supplier entities entering data related to assets in a centralized database.

As to the UPC catalog, *Perkowski* states that " the manufacturer organizes and sends the data ... to be loaded into the UPC Catalog database." (col. 1, lines 53-56). Thus the UPC catalog data is entered by the manufacturers. As to the sales and analysis forecasting subsystem and collaborative replenishment subsystem *Perkowski* implies that retailers input this information (e.g., "providing retailers with information about what products consumers are buying," col. 2, lines 8-10; "determining what products retailer can be buying in order to

satisfy consumer demand at any given point of time," col. 2, lines 10-12). As to the transportation and logistics information subsystem, *Perkowski* states that this is "for producing and providing retailers with information about when products purchased by them (at wholesale) will be delivered to their stores," thus implying that this data is entered by freight carriers. Nowhere does *Perkowski* teach or suggest that two or more independent supply chain entities record data into a centralized database regarding an asset.

Further, *Perkowski* is silent as to entering data regarding particular instances of assets by the supply chain entities that process the particular instance of the asset. As Applicants have previously argued, *Perkowski* is silent as to entering data regarding particular instances of assets because *Perkowski* does not teach or suggest any references that are particular to individual asset items. *Perkowski* describes accessing data via a UPC that is attached to a product, and it is well known that a UPC is only unique to types of products, and not to particular instances of a product.

In addition, with regard to Claim 7, the Examiner did not demonstrate that *Perkowski* discloses data being recorded by an upstream entity that is associated with an instance of a first asset and data being recorded by an downstream entity that is associated an instance of a second asset, wherein the instance of the second asset possesses the instance of the second asset as a constituent. The Applicants submit that *Perkowski* fails to teach these aspects of Claim 7. In particular, the Examiner has not shown where *Perkowski* discloses associating a URL of a first asset with a URL of a second asset that is a constituent of the first asset. In the Office Action, the Examiner states that "[i]nherent in the related products are components of a product that are sold separately." The Applicants disagree with the assertion that *Perkowski* inherently describes products having a constituency relationship, and therefore fails to describe associating URLs between such products. As stated in *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted):

> To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may

not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. (emphasis added)

Thus, to establish that *Perkowski* inherently teaches "related products", the Examiner must establish that is it clear that these recitations are necessarily present in the system of *Perkowski*, and that persons of ordinary skill would recognize that *Perkowski's* system includes this claimed feature. The Examiner states that "figure 4A1 shows a personal computer. Figure 4B shows a Netscape Navigator, which could be a component part of the computer and would be listed as a related product."(Office Action, page 5)(emphasis added). Whether or not Netscape Navigator could be a component part of a computer is not sufficient to establish inherency, the Examiner must show that Netscape Navigator is necessarily present in the computer as disclosed by *Perkowski*. However, *Perkowski* only states that related products "may satisfy the goals or objectives of a particular advertising and/or marketing campaign or product promotion program of the registrant company." (column 19, lines 43-46). The Applicants respectfully submit that this is insufficient to establish that *Perkowski* inherently describes a constituency relationship between two assets, and therefore further fails to anticipate Claim 7.

Applicants thus respectfully submit that independent Claims 1, 7, 12, 21, 30, 34 and 39 are not anticipated by *Perkowski*, and are in condition for allowance. Dependent Claims 2, 4-6, 10-11, 13-20, 22-29, 31-32, 35-38, and 40, are dependent from independent Claims 1, 7, 12, 21, 30, 34, and 39 respectively. The particular limitations in these claims were not specifically addressed in the Office Action, and therefore the Applicants submit these rejections are improper under M.P.E.P. § 707.07(d). Further, the Applicants respectfully submit that *Perkowski* fails to teach the features identified in these claims. To the extent that some of the dependent claim features may have been addressed, the Applicants do not acquiesce with the particular rejections to these dependent claims, including any assertions of inherency or the taking of Official Notice. In any event it is believed that these rejections are moot in view of the remarks made in connection with independent Claims 1, 7, 12, 21, 30, 34, and 39. These dependent claims include all of the limitations of the base claims and any intervening claims, and recite additional features which further distinguish these claims

from the cited references. Therefore, dependent Claims 2, 4-6, 10-11, 13-20, 22-29, 31-32, 35-38, and 40 are also in condition for allowance.

Authorization is given to charge Deposit Account No. 50-3581 (HONY.030PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him at to discuss any issues related to this case.

Respectfully submitted,

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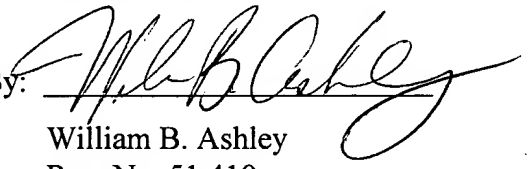
By: 

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